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EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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01/08/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/734,290	HOBBS, GEORGE BRADLEY	
	<b>Examiner</b>	<b>Art Unit</b>	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

**Detailed Action**

**Specification**

**Status of the claims**

Claims 1-26 and 29-34 are currently being pending, while claims 27, 28 and 35-40 were canceled.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 11-20, 21-26 and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satomi, US 2004/0039641 in view of Hoyle, USP 6,141,010.

As per claims 1-10, 11-20, 21-26 and 29-34, Satomi discloses a terminal apparatus/kiosk (user interface) for obtaining, over a communication link or the Internet, desired information from information providers and prints the information in high quality as needed. The terminal adds at least one advertisement information to the desired information (print job), which reduces the cost for obtaining and printing the desired information from an information provider over the network or communication link. The terminal calculates the advertisement fee by counting the

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number of printing of the advertisement. The terminal charges the user, up to the maximum limit desired, for the information obtained and printed according to the print amount (Reading on defining an information provider system or print processing system controller having or storing therein desired information/content (potential print job) and at least one recorded or registered advertisement, defining a network communication link (an Internet connection) between a customer's interface/terminal and the information provider system or print processing system controller, receiving a request (print job) from a customer for a desired content by the information provider system, wherein the request needs to be processed and printed (processing a job ticket) at the terminal and inserting an advertisement into the printed content). (See abstract; fig. 1 [0026]-[0032]).

**In Fig. 6, step S605 displays the preview image received in the step S601, but there may be displayed a preview image in consideration of the output format of the advertisement selected by the user in the "advertisement setting". In such case, the output format of the advertisement currently selected by the user, is transferred to the CanDINet control unit (print control unit), thereby causing the CanDINet control unit to prepare the preview image data with the advertisement. Then such image data are received to display the preview image with advertisement (at least a preview image of the advertisement is displayed on the user's screen, while the user interacts with the interface (screen) with an input device or a mouse to generate a print job ticket or submit a print job, before such advertisement is printed together with the printout of the requested content or print job. [0208]).** Further, If the "advertisement setting" button [2903] is depressed in the list image shown in FIG. 29 (step S603 advertisement setting), there is displayed an "advertisement setting"

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image as shown in FIG. 31 (step S604), and there is executed a process for print charge settling (step S609) [0209]. Here, in the print service, the user pays a print charge, including the service charge, at the printing of the information provided by the information provider 130 of fig. 2. However, if an **advertisement** is inserted in the print job, then a part of the print charge is being discounted accordingly. The amount of reduction of the print charge varies according to the mode of insertion of the **advertisement** and the amount thereof [0211-0215]. The type of advertisement inserted into the print job or requested content or printout is based in part on a keyword [0178].

See in general figs. 6, 29-31; [0117-0131]; [0204]; [0208-0209]; [0306]; [0350-0352] and [0358].

As per claims 1, 11, 21, 33 and 34, although Satomi **discloses that at least a preview image of the advertisement is displayed on the user's screen, while the user interacts with the interface (screen) with an input device or a mouse to generate a print job ticket or submit a print job, before such advertisement is printed together with the printout of the requested content or print job ([0 208])**, however, Satomi does not expressly disclose displaying the advertisement or ad on the customer's interface (computer screen or display), instead of printing it on the print job or printout, while the (print processing) system processes the print job (ticket) or printout.

However, Hoyle teaches, inter alia, a method of and apparatus for providing an automatically upgradeable software application (interface) that includes targeted advertising based upon a user's **demographics** and interaction with a computer. The software application is a

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graphical user interface that includes a display region used for banner advertising that is downloaded from time to time over a network such as the Internet. The software application is accessible from a server via the Internet and demographic information on the user is acquired by the server and used for determining what banner advertising will be sent to the user. The software application (interface) further targets the advertisements in response to normal user interaction or use of the computer. Associated with each banner advertisement is a set of data or attributes that is used by the software application in determining when a particular banner ad is to be displayed in a region of the software application (interface). This includes the specification of certain programs that the user may have so that, when the user runs the program or interface (such as a spreadsheet program), an advertisement will be displayed that is relevant to that program (such as an advertisement for a stock brokerage). The software application includes programming that accesses the server on occasion to determine if one or more components of the application need upgrading to a newer version. If so, the components are downloaded and installed without requiring any input or action by the user (displaying a targeted banner advertisement in a region of a software application or interface in response to a user's action-See abstract; figs. 5, 5a and 7 and related embodiments).

Finally, it is common practice in the art to display a banner ad or pop-up ad on a user's screen while the user interacts with a program (interface) or browses the Net.

Thus, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure (Hoyle and the well recognized practice of displaying an ad on the user's computer) into the advertising distribution and printing system of Satomi so as to display an advertisement on the screen of a user's computer or within a software

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application (such as a word processor or a spreadsheet) or within a user's interface upon receiving an input from the user, while processing a print job, instead of printing the advertisement along with the user's document associated with the print job especially if the printed document is addressed to a third party, such a prospective employer or recruiter, who should not receive or be exposed to the printed advertisement in the first place, thereby avoiding the embarrassment resulting from knowingly or accidentally printing an advertisement within a page of a document that may be addressed to a third party or a VIP, such a prospective employer or a president of a hiring corporation, and efficiently using a dedicated region within the user's interface or software application by outputting or displaying the advertisement in the dedicated region within the user's interface or software application, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface) as the user executes a task or function within the software application or processes a print job.

### **Response to Applicant's Arguments**

Applicant's arguments with respect to the claimed invention have been considered, but are moot in view of the new ground(s) of rejection. In other words, the Applicant's arguments are based on the newly amended claims and are fully addressed here and in the Office Action.

Moreover, the amended claims recite "presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job, including displaying the advertisement on the interface of the customer, **wherein the advertisement is presented to the customer while the customer interacts with**

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**the interface with an input device to generate the job ticket**", the "wherein clause" does not further limit the claim, which recites at best "displaying the advertisement on the customer's interface when the processing system processes the job ticket, related to the print job, submitted by the customer. First, to submit a print job, the customer has to interact (use) with the system and the advertisement is displayed on the customer's interface or screen, not on the printed material related to the print job, while the print job is being processed. Second, the latter limitation was included in the claim. Further, although it appears that the "wherein clause" silently invokes some kind of timing therein, however, no timing is positively recited in the claim(s). Arguendo, even if a timing period was included in claim(s), that would constitute at best a matter of desires, which would not directly impact the utility or functionality of the system by which an advertisement is displayed on the customer's screen or interface, not on a printed material, when or while the print job is being processed. To this end, the "wherein clause" does not bring much into the claim(s) and may represent an "Intended Use" recitation, as one of ordinary skills in the art would have concluded at the time of the invention.

Additionally, Petrecca discloses, in general, displaying an advertisement on a user's screen or interface during waiting period that is customary in a computer-related transaction such as during the start up of a program, sending of information from a computer to a peripheral device like a printer (e.g. when a print job is sent to a printing device), modem or fax. For instance, when a print job is sent to a printer by a user, there is a delay between the time the user issues the print command (interaction) and the time the printer actually receives and executes the command therefrom and an appropriate advertisement is displayed on the user's interface during



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the interval or delay. Thus, Petrecca, contrary to the Applicant's contention, does not in any way teach away from the claimed invention.

**Furthermore, although Applicant submits that the amended independent claims include “automatically presenting the advertisement to the customer while the customer interacts with the interface with an input device to generate the job ticket”, however, the Examiner notes that the amended claims simply recite “presenting the advertisement to the customer while the customer interacts with the interface with an input device to generate the job ticket”. In other words, the argued limitations are not necessarily claimed.**

Finally, the concept of displaying an ad on a user's computer while the user's interacts with the system or computer is well known in the art of banner ad or pop up ad.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response and the current **Office Action has been made Final.**

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,383,129 to Farrell. There is provided a method of estimating cost of printing materials used to print a job on a printing apparatus. The method includes the steps of: storing billing rates reflecting the cost of printing materials to be used in printing the job, selecting a first quantity of printing materials to be used in printing the job, and, prior to printing the job,

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calculating, as a function of the first selected quantity of printing materials and one of the stored billing rates, a first printing materials cost of the job.

USP 6,025,925 to Davidson discloses an improved printing system having at least one host computer and a printer in which the printer acquires print job accounting information and communicates it to the host computer via NPAP messages. A host computer downloads print job data to the printer through a communications port on the printer (i.e., either a parallel port, serial port, or network port), and as the printer prints the print job that it received from the host computer, the printer temporarily stores job accounting information. At the end of the print job, the printer communicates that job accounting information back to armed host computers via a bi-directional communications port, including typical information such as: the job identifier number, job processing time, number of sheets of paper from each paper source, number of impressions from each paper source (either one-sided or two-sided impressions), the port identifier, the network user name, the name of the print job (as specified), and the printer's serial number. Since the data is being accumulated at the printer, rather than at the host computer, there is no estimating by a host-resident program to acquire these statistics, and no database merging (from several host computers) is required to categorize all of the data for one particular printer. Furthermore, the print jobs need not pass through a network queue in order to be detected and accounted for.

USP 5,802,420 to Garr discloses an improved printer that predicts how many pages can be printed before the toner or ink cartridge becomes empty and also predicts how much time remains before this toner or ink cartridge becomes empty. This prediction is based upon the previous printing history of the printer while using this particular toner cartridge. After

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measuring the quantity of toner left in the toner cartridge, the printer of the present invention will display the approximate quantity of toner remaining in the cartridge on a screen of a host computer that is connected to the printer, either directly or through a network. The monitor screen of the host computer can also display the predicted number of pages remaining, based on the printer's previous usage history as described above. The toner measuring device provides a "level change" output signal when the remaining toner passes through a predetermined gradation threshold, and depending upon the size of the toner cartridge and upon the time and date at which the level change was detected, the predicted number of pages remaining and the actual amount of toner remaining are more accurately updated upon reaching one of these predetermined gradation thresholds. As each gradation level transition occurs, the printer calculates a new value for the "pages per gradation" variable, and also calculates the number of pages that have been printed since the latest cartridge was installed in the printer, the number of pages printed since the last level or gradation change, and the number of pages or sheets printed between the last two level changes. The printer also can approximate the amount of toner used in printing a particular page of print media to create a Toner Tally for each printed page, which can be used to judge the amount of toner used for one print job and compare that to the amount of toner used for a second print job. The Toner Tally uses a combination hardware/software counter to count the number of "active" pels of each page for a print job.

USP 5,305,195 to Murphy discloses a method a new system for providing advertising information into an interactive system having a plurality of remotely located terminals. Each terminal includes a video display unit, logic and a video storage medium such as a hard disc in addition to the normal functions of the interactive system of which an ATM is an example. A

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remote centrally located commercial computer capable of transmitting digitized signals representing commercial offerings and compressed digitized video signals for display on the video unit communicates with each of the remotely located terminals. The compressed digitized video signals are stored on the hard disc of each terminal for display on the video unit at times determined by the use of the terminal. The user selects the services or goods offered by the terminal in the conventional manner. During the waiting time inherent in the operation of the terminal a high quality video advertising message is displayed on the video unit from the hard disc. The message will last for less than 15 seconds and the user selected function will continue at the conclusion of the message. The advertising message will be changed, updated and varied directly from the central computer (See abstract).

USP 6,628,417B1 to Naito discloses a data communication apparatus, which serves as a server connected to a predetermined network, comprising: image saving means for saving first image data for display and second image data having a higher resolution than the first image data; transmission means for sending the first image data to a client via the network in accordance with a request from the client on the network; reception means for receiving a print request including a print size from the client via the network; calculation means for calculating a size of print image data, which is to be generated from the second image data corresponding to the first image data, on the basis of the print size included in the print request, when the print request is received; processing means for processing the second image data to obtain print image data in accordance with the size calculated by said calculation means; and output means for outputting the print image data obtained by said processing means to predetermined print means (See abstract).

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

12/29/08

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688

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